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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/063,734 05/20/93 SIMONE

EXAMINER
C. S4264.000P00

SHINGALA,G

23M1/0113

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WASHINGTON, DC 20037

ART UNIT	PAPER NUMBER
2311	5

DATE MAILED:

01/13/94

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |  |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948.        |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.      | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/> _____  |

**Part II SUMMARY OF ACTION**

1. ☒ Claims 1 <sup>is</sup> pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☒ Claims 1 <sup>is</sup> are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

7. ☒ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 20, lacks antecedent basis for "said plurality of individuals".

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claim 1 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter -- in particular, a method of doing business.

Claims reciting a method of doing business do not fall within the statutory classes set forth in 35 U.S.C. § 101. See Hotel Security Checking Co. v. Lorraine Co. 160 Fed. 467 (1908), In re Wait, 24 USPQ 88 (CCPA 1934), Loew's Drive-In Theatres v. Park-In Theatres Inc., In re Patton, 53 USPQ 376 (CCPA 1942), 81 USPQ 149 (Court of Appeals, 1st Circuit, 1949), and Ex parte Murray, 9 USPQ 2d 1819 (PTO Bd. Pat. App. & Int'f., 1988).

The present set of claims populated with steps or means, stated and repeated in various levels of detail, for performing functions which clearly comprise a method of doing business. Some

examples follow:

gathering information, receiving and storing information, assigning weight values for each information, assigning weight values for each information, determining a total value, comparing each information and providing suggestion and a level of insurance risk.

These are functions normally performed by a insurance sales agent and thus may be characterized as a method of doing business.

The nominal recitation of "computer" and "memory" does not render the claims statutory in view of Ex parte Akamatsu, 22 USPQ 1915 (1992) and Gottschalk, Commr. Pats. v. Benson, 175 USPQ 673 (1972).

It is the position of the examine that, considering the widespread use of computers to perform business functions, the nominal recitation of a computer to perform a business functions, the nominal recitation of a computer to perform a business function fails to define a "specific apparatus distinct from other apparatus capable of performing the identical functions" (as required by Walter). The nominal recitation of a computer may rule out pre-emption with respect to a "pencil and paper" mode of performing business, but leaves intact the issue of "practical pre-emption" (as defined by Benson).

More in general, in evaluating whether a case recites a statutory subject matter under 35 U.S.C. 101, "the claimed invention, as a whole, must be evaluated for what it is", In re

Sarker, 200 USPQ 132. As paraphrased in In re Abele, "The goal is to answer the question 'What did the applicant's invent?'. Resolving these basic inquired "careful interpretation of each claim in light of its supporting disclosure". In re Johnson, 200 USPQ at 208. It is apparent from the specification of the present application that the inventive premise resides in a business instrument or technique.

Recitation of a computer should not shroud the issue of this case. General purpose computers are simply tools in performing a business function in the same genre as pencil, paper, handheld calculator, etc. On this basis, examiner respectfully submits that the recitation of a computer in a claim should be treated in the same light as these other "de-mystified" business tools.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by DeTore et al. (4,975,840).

As pr claim 1, DeTore et al. discloses a method and apparatus for evaluating a potentially insurable risk comprising gathering information pertaining to individual's lifestyle, health and medical test and storing this information (col. 4, lines 24-35). Each of the information is assigned a weighted value that

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represents a level of insurance risk (col. 2, lines 1-14). The gathered information is compared with a predefined suggestion and providing a message containing the suggestion (col. 2, lines 31-38 and col. 21 and 22, "Treatment" section and col. 35 and 36) and provide an analysis of the level of insurance risk (col. 18, lines 23-32).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

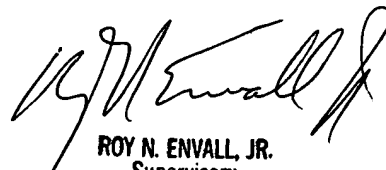
The cited prior discloses various methods and apparatus for finding a certain future liability of uncertain value and its cost.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gita Shingala whose telephone number is (703) 305-9777.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.



GS/hh  
January 12, 1994



ROY N. ENVALL, JR.  
Supervisory  
Patent Examiner  
Group 2300